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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/251,480	02/17/1999	KAMRAN AMJADI	24122-402	3291
909	7590	04/22/2005	EXAMINER	
PILLSBURY WINTHROP SHAW PITTMAN, LLP P.O. BOX 10500 MCLEAN, VA 22102			DINH, KHANH Q	
			ART UNIT	PAPER NUMBER
			2151	

DATE MAILED: 04/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	09/251,480	AMJADI, KAMRAN	
	Examiner	Art Unit	
	Khanh Dinh	2151	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1/28/05, 8/18/99, 9/11/99;</u> | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/28/2005 has been entered.

2. Claims 1-53 and new claims 54-59 are presented for examination.

Claim Rejections - 35 USC ' 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined

under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-36, 39-41, 44-50 and 52-59 are rejected under 35 U.S.C. 102(e) as being anticipated by Scroggie et al., U.S. Pat. no.5,970,469.

As to claim 1, Scroggie discloses a computer method performed for providing access to incentives via a computer network, the computer network comprising at least one incentive host server (310 fig.13) and at least two network servers (300, 312 fig.13) for providing users with access to incentives host server (310 fig.13), comprising:

receiving, at a network server, an access request from a client device (user 308 fig.13) associated with the user and transmitting a first identifier and a network server identifier (NID) (customer ID) corresponding to the access request to the incentive to a host server (see abstract, figs, 1, 13, col.11 line 41 to col.12 line 42);

determining at the incentive host server available incentives using at least the first identifier and the NID, wherein the NID is used to identify available incentives in an incentive server database (306 fig.13) associated with the NID (i.e., using purchase incentive data to process users' purchases), and transmitting information (token) regarding the determined available incentives to the client device (see col.11 line 41 to col.12 line 42 and col.13 lines 10-46).

As to claim 2, Scroggie discloses receiving a request for a document stored at least in part on the network server (see col.11 line 41 to col.12 line 42).

As to claim 3, Scroggie discloses determining whether an indication exists that the user subscribes to receive information of at least one of the subscriber identification and a server identification associated with available incentives (see col.6 lines 1-64 and col.12 lines 7-51).

As to claim 4, Scroggie discloses determining whether an indication exists that the user subscribes to receive information of at least one of the subscriber identification and a server identification associated with available incentives, includes: transmitting a subscriber request to the client device and receiving a response from the client device including the first identifier (see col.6 lines 1-64 and col.12 lines 7-51).

As to claim 5, Scroggie discloses transmitting an identifier corresponding to the client device to the incentive host server and transmitting a network server identifier corresponding to the network server (see fig.13, see col.6 lines 1-64 and col.12 lines 7-51).

As to claim 6, Scroggie discloses receiving incentive information reflecting a selection of incentives based on at least one of the subscriber identification and the identifier corresponding to the client device to the incentive host server and

the network server identifier corresponding to the network server (see fig.13, see col.6 lines 1-64 and col.12 lines 7-51).

As to claim 7, Scroggie discloses transmitting a first identifier corresponding to the device associated with the user (see fig.13, see col.6 lines 1-64 and col.12 lines 7-51).

As to claim 8, Scroggie discloses a computer-implemented method for accessing incentives in a network, comprising:

- transmitting an access request to access one of the network servers (300, 312 FIG.13) in the network (see abstract, figs,1, 13, col.11 line 41 to col.12 line 42);

- transmitting a first identifier and a network identifier (NID) corresponding to the access request to the incentive host sever (310 FIG.13) (i.e., using purchase incentive data to process users' purchases) and determining available incentives using at least the first identifier and the NID, wherein an incentive host server (300 fig.13) identifies available incentives in an incentive server database (306 fig.13) associated with the NID (see col.11 line 41 to col.12 line 42 and col.13 lines 10-46).

As to claim 9, Scroggie discloses providing a browser enabling a user to formulate and transmit the access request (see fig.13, see col.6 lines 1-64 and col.12 lines 7-51).

As to claim 10, Scroggie discloses receiving selected incentive information reflecting a server identification associated with the server, wherein the network server provides the NID to the incentive host for identification of the incentive information (see fig.13, see col.6 lines 1-64 and col.12 lines 7-51).

Claims 11-20 are rejected for the same reasons set forth in claims 1-10 respectively.

As to claim 21, Scroggie discloses a system for distributing information in a network, comprising:

- a host server (300 fig.13) having at least one of an incentive distribution module and an account creation module accessible to a plurality of users, a plurality of network servers (310, 312 fig.13) coupled to and selectively accessible to the host server for providing identification including a first identifier and an network server identifier (NID) to the host server (see abstract, figs,1, 13, col.11 line 41 to col.12 line 42);

- at least one client machine (302 fig.13) coupled to and selectively accessible to at least one of the network servers for accessing network documents, wherein when at least one user (308 fig.13) causes the client machine to access one of the network servers, the accessed network server communicates with the host server to obtain data corresponding to the subscriber for presentation to the at least one user, and wherein the at least one

client machine is adapted to present from the host for at least one user (i.e., using purchase incentive data to process users' purchases, see col.11 line 41 to col.12 line 42 and col.13 lines 10-46).

As to claims 22-34, Scroggie further discloses using coupons, set of coupons, discounts and awards (see col.10 lines 5-59 and col.12 lines 7-51).

As to claims 35 and 36, Scroggie further discloses transmitting to the client request and registration form for an account (using log-in page), receiving information regarding an account, determining an identifier and transmitting the first identifier to the client device (see col.6 line 35 to col.7 line 52).

Claims 39-41 are rejected for the same reasons set forth in claims 34-36 respectively.

Claims 44-47 are rejected for the same reasons set forth in claims 39-42 respectively.

As to claim 48, Scroggie further discloses one or more database for storing information related to coupons (see fig.10, col.9 line 42 to col.10 line 39).

Claims 49-50 are rejected for the same reasons set forth in claims 40-41 respectively.

Claims 52 and 53 are rejected for the same reasons set forth in claims 34 and 39 respectively.

As to claim 54, Scroggie discloses an incentive host server (310 fig.13) for use in an incentive network, the incentive network including the incentive host server including at least two incentive network servers (300 and 312 fig.13), comprising:

- an incentive database (306 fig.13) for storing incentives;

- a registration module (using a log-in page and household Registration to process user's data information, see col.9 lines 15-40) for receiving registration information from a client device (302 fig.13), and for transmitting a Unique ID (client ID) to the client device that submitted the registration information for storage on the client device to enable the ID to be subsequently used in connection with requesting incentives from any of the incentive network servers within the incentive network (see col.6 lines 35-64 and col.11 lines 42-65);

- an incentive determination module for:

- receiving a request for incentives from any of the incentive network servers and receiving a UID and a network ID (NID) associated with the request (see fig.14, col.11 line 66 to col.12 line 42).

- determining currently available incentives based on the UID and a UID of the client device from which request was initiated and transmitting information about the incentives determined to be currently available (see col.12 line 43 to col.13 line 35).

As to claim 55, Scroggie further discloses that the incentive determination module for

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transmitting information about the incentives determined to be currently available to a client device having the UID associated with the received request (see col.12 line 43 to col.13 line 35).

As to claim 56, Scroggie further discloses the incentive determination module for transmitting information about the incentives determined to be currently available to the incentive network server having the NID associated with the received request (see col.8 line 53 to col.9 line 40 and col.12 line 43 to col.13 line 35).

As to claim 57, Scroggie further discloses an incentive network, comprising:

an incentive host server (310 fig.13) and at least two incentive network servers (300 and 312 fig.13), wherein an incentive network server comprises a network interface for receiving from a client device (302 fig.13) a request for access to incentives, and for communicating information about the request to the incentive host server (see abstract, fig.13, col.11 lines 42-65); and

the incentive host server comprising:

- i) an incentive database (306 fig.13) for storing incentives;
- ii) a registration module (using a log-in page and household Registration to process user's data information, see col.9 lines 15-40) for receiving registration information from a client device (302 fig.13), and for transmitting a Unique ID (client ID) to the client device that submitted the registration information for storage on the client device to enable the ID to be subsequently used in connection with requesting incentives from any of the incentive network

servers within the incentive network (see col.6 lines 35-64 and col.11 lines 42-65);

iii) a network interface for receiving from any of the incentive network servers a request for access to at least some of the stored incentives, and receiving a request for incentives from any of the incentive network server from which the request is received (see fig.14, col.11 line 66 to col.12 line 42).

iv) an incentive determination module for determining currently available incentives based on the UID and a UID of the client device from which request was initiated and means for transmitting information about the incentives determined to be currently available to the UID and UID combination (see col.12 line 43 to col.13 line 35).

Claims 58 and 59 are rejected for the same reasons set forth in claims 55 and 56 respectively.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 37, 38, 42, 43 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scroggie et al., U.S. Pat. no.5,970,469 in view of Gardenswartz et al. US pat. No.6,055,573.

Scroggie's teachings still applied as in item 4 above. Scroggie does not specifically disclose demographic information regarding a user and the requested document is stored on the network server. However, Gardenswartz further discloses demographic information regarding a user and the requested document is stored on the network server (see fig.1, col.5 lines 33 to col.6 line 53, col.7 line 12 to col.8 line 32 and col.13 line 51 to col.14 line 48). It would have obvious to one of the ordinary skill in the art at the time the invention was made to implement Gardenswartz's teachings into the computer system of Scroggie to process data transactions over the Internet because it would have tracked a consumer's online activity and thus delivered appropriate product information to consumers based on purchase history over the Internet.

Response to Arguments

7. Applicant's arguments with respect to claims 1-59 have been considered but are moot in view of the new ground(s) of rejection.

Other prior art cited

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. LeMole et al., US pat. No.6,009,410.

Conclusion

9. Claims 1-59 are rejected.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh Dinh whose telephone number is (571) 272-3936. The examiner can normally be reached on Monday through Friday from 8:00 A.m. to 5:00 P.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung, can be reached on (571) 272-3939. The fax phone number for this group is (703) 872-9306.

A shortened statutory period for reply is set to expire THREE months from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned (35 U. S. C . Sect. 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(A).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval IPAIRI system. Status information for published applications may be obtained from either Private PMR or Public PMR. Status information for unpublished applications is available through Private PAIR

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only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Khanh Dinh
Patent Examiner
Art Unit 2151
4/15/2005